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10/808,799	03/25/2004	Barry J. Lipsky	P68/500578.20072	6031

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EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2435

MAIL DATE	DELIVERY MODE
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02/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/808,799	Applicant(s) LIPSKY ET AL.	
	Examiner THANHNGA B. TRUONG	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on December 1, 2008. Claims 18-31 are pending. At this time, claims 18-31 are still rejected.

Response to Arguments

2. Applicant's arguments with respect to claim 18-31 have been considered but are moot in view of the new ground(s) of rejection.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

Information Disclosure Statement

3. The information disclosure statement (IDS) filed on May 28, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18 and 25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicant has amended this limitation **“said file system does not provide for transferring a copy of the database file that is fully operative outside said hand held electronic reference product”** of claims 18 and 25, which is critical or essential to the practice of the invention, but not included in the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is a reminder to the applicant that any amended limitation, which does not support by the specification, is considered to be a new matter. Appropriate correction is required.

Claims 19-24 and 26-31 are depended on claims 18 and 25 respectively, thus they are rejected with the same rationale applied against claims 18 and 25 above.

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-20, 24-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1), in view of Cronic (US 7,032,240 B1), and further in view of Schena et al (US 6,314,457 B1).

a. Referring to claims 18:

i. Mankoff teaches in a system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), the security validation subsystem comprising:

(1) a serial identification number for one of said hand held product and said file system (**paragraph [0032] of Mankoff**),

(2) a first voucher in said database file, said first voucher based on said serial identification number (**paragraph [0032] of Mankoff**), and

(3) a second voucher in said product at a location outside of said database file, said second voucher based on said serial identification number (**paragraph [0032] of Mankoff**),

(4) a comparator program within the PC reader to read and compare said first and second vouchers to provide a validation signal if said vouchers meet a predetermined correspondence comparison criterion (**paragraph [0032] Mankoff**),

(5) said validation signal permitting decryption (e.g., encryption scheme) by the PC of said database file (**paragraph [0032] of Mankoff**), wherein said database file is accessed using said file system on the handheld electronic reference product (**see Figure 2 and paragraph [0023, 0026-0027] of Mankoff**).

ii. Although Mankoff teaches the system for coupling a hand held electronic reference product having an encrypted database file and a file system to a PC having a reader so that the PC can process the database file (see Figures 1-2 of Mankoff), Mankoff is silent on the capability of showing the PDA or handheld device included a serial identification number (if indeed is not inherent). On the other hand, Cronic teaches this limitation in **column 11, lines 35-38 of Cronic**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Mankoff with the teaching of Cronic for authorizing the use of protected information and, in particular, to a portable authorization device (commonly known as a "dongle") for authorizing a host system to use protected information (**column 1, lines 15-19 of Cronic**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Mankoff with the teaching of Cronic to provide a portable authorization device that offers a high level of security to prevent unauthorized access to the authorization information when stored or being transmitted (**column 3, lines 37-40 of Cronic**).

v. Although the combination of teaching between Mankoff and Cronic teaches the claimed subject matter, they are silent on the capability of showing wherein said file system does not provide for transferring a copy of the database file that is fully operative outside said hand held electronic reference product. On the other hand, Schena teaches this limitation in column 8, lines 32-46 of Schena.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the modified-invention of Mankoff with the teaching of Schena for improving the copyright protection.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the modified-invention of Mankoff with the teaching of Schena to provide a secure accessing to the copyrighted material database (**column 18, lines 8-9 of Schena**).

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b. Referring to claim 19:

i. Mankoff further teaches:

(1) said vouchers are based on a serial number in said file system **(paragraph [0032] of Mankoff)**.

c. Referring to claim 20:

i. The combination of teaching between Mankoff and Cronic teaches the claimed subject matter. Mankoff and Cronic further teaches:

(1) said vouchers are based on a serial number of said hand held product **(paragraph [0032] of Mankoff and column 11, lines 35-38 of Cronic)**.

d. Referring to claim 24:

i. Mankoff further teaches:

(1) said predetermined criterion is identity between said vouchers **(paragraph [0032] of Mankoff)**.

e. Referring to claims 25-27 and 31:

i. These claims consist the security validation method of providing access by a PC to an encrypted database file stored in a hand held electronic reference product, said hand held electronic reference product having a file system to implement claims 18-20 and 24, thus they are rejected with the same rationale applied against claim 18-20 and 24 above.

8. Claims 21-23, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff (US 2002/0116271 A1) as applied to claims 18 - 20 and 24 above, in view of Cronic (US 7,032,240 B1), view of Schena et al (US 6,314,457 B1), and further in view of Kobayashi (US 6,708,182 B1).

a. Referring to claims 21-23, 28-30:

i. Although the combination of teaching between Mankoff, Cronic, and Schena teaches the claimed subject matter, they are silent on the capability of including the voucher (e.g. message format) in the header field. On the

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other hand, Kobayashi teaches this limitation in **column 2, line 57 through column 3, line 14 of Kobayashi**.

ii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the modified-invention of Mankoff with the teaching of Kobayashi to provide a portable electronic apparatus and message processing method which can decode a plurality of message format (**column 1, lines 35-37 of Kobayashi**).

iii. The ordinary skilled person would have been motivated to:

(1) have modified the modified-invention of Mankoff with the teaching of Kobayashi to enhance the data that contains in the header field.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone

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numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2435

TBT

February 9, 2009